

ESTTA Tracking number: **ESTTA690538**

Filing date: **08/19/2015**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

## Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

### Opposer Information

Name	The Ohio State University
Granted to Date of previous extension	08/19/2015
Address	190 North Oval Mall Columbus, OH 43210 UNITED STATES
Attorney information	SAMANTHA M QUIMBY FROST BROWN TODD LLC 10 WEST BROAD STREET, SUITE 2300 COLUMBUS, OH 43215 UNITED STATES fbtiplitigation@fbtlaw.com, squimby@fbtlaw.com, kcomella@fbtlaw.com Phone:614.559.7282

### Applicant Information

Application No	86450687	Publication date	04/21/2015
Opposition Filing Date	08/19/2015	Opposition Period Ends	08/19/2015
Applicant	Herbert, Dean L 41 Gregory Street Wembley, 6014 AUSTRALIA		


### Goods/Services Affected by Opposition

Class 009. First Use: 2007/07/07 First Use In Commerce: 2007/09/16 All goods and services in the class are opposed, namely: Computer game software; Computer game software downloadable from a global computer network; Computer game software for use on mobile and cellular phones
Class 041. First Use: 2007/09/16 First Use In Commerce: 2007/09/16 All goods and services in the class are opposed, namely: Entertainment services, namely, providing online video games

### Grounds for Opposition

False suggestion of a connection	Trademark Act section 2(a)
Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)

### Mark Cited by Opposer as Basis for Opposition

U.S. Registration No.	1121595	Application Date	01/29/1975
Registration Date	07/03/1979	Foreign Priority Date	NONE
Word Mark	OSU		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 041. First use: First Use: 1878/05/01 First Use In Commerce: 1878/05/01 PROVIDING COLLEGE SPORT EXHIBITION EVENTS AND RECREATION PROGRAMS, PROVIDING DRAMATICAL AND MUSICAL ENTERTAINMENT EVENTS AND PROVIDING COLLEGE LEVEL EDUCATIONAL COURSES		

Attachments	73042961#TMSN.png( bytes ) Notice of Opposition re OSU!.pdf(1100740 bytes ) Exhibit A to Notice of Opposition re OSU!.pdf(370815 bytes ) Exhibit B to Notice of Opposition re OSU!.pdf(255664 bytes )
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## Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/samantha m quimby/
Name	Samantha M. Quimby
Date	08/19/2015

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

IN THE MATTER OF:      Application Serial No. 86/450,687  
DATE OF PUBLICATION: April 21, 2015

The Ohio State University,	)	
	)	
Opposer,	)	
	)	
v.	)	Opposition No.
	)	
Dean L. Herbert TA ppy Pty Ltd ACN 163	)	
593 413,	)	
	)	
Applicant.	)	
	)	

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**NOTICE OF OPPOSITION**

THE OHIO STATE UNIVERSITY, an Ohio Educational Institution (state university), having a principal place of business at 190 North Oval Mall, Columbus, Ohio 43210 believes it will be damaged by registration of Application Serial No. 86/450,687 for the Applied-for Mark OSU! filed by Dean L. Herbert TA ppy Pty Ltd CAN 163 593 413, (hereinafter the “Applicant”) and published for use on “Computer game software; Computer game software downloadable from a global computer network; Computer game software for use on mobile and cellular phones” in Class 9, and “Entertainment services, namely, providing online video games in Class 41,” hereby opposes the same under the provisions of Section 13 of the Trademark Act of July 5, 1946, codified at 15 U.S.C. § 1063.

As grounds therefore, it is alleged:

1. Established in 1870, The Ohio State University (hereinafter “OSU” or “Opposer”), has developed into one of the most well-respected institutions of higher learning in the country.
2. For over 140 years, OSU has provided college and graduate level educational courses, sponsored collegiate sporting events and recreation programs, and staged dramatic and musical entertainment events.
3. OSU licenses and markets many items using the trademarks “OSU”, “Buckeyes” (the name designation for OSU’s students, athletes and alumni), “Brutus Buckeye” (the name of OSU’s beloved mascot), “Go Bucks”, the distinctive “scarlet and gray” color scheme, and the signature “Buckeye Leaf” (collectively, the “OSU Marks”).
4. OSU’s academic and athletic programs rank among the best in the nation. It’s undergraduate program and graduate programs for law, medicine, business, engineering, and education are all currently ranked among the top 40 schools in the nation in their respective areas by U.S. News & World Report.
5. OSU’s athletic programs have a long history of success. OSU is among only five universities with NCAA championships in baseball, basketball and football. OSU athletic teams have also won national championships in men’s swimming and diving, men’s outdoor track and field, men’s golf, men’s gymnastics, men’s fencing, co-ed fencing, synchronized swimming, and men’s volleyball.
6. Most recently, in January of 2015, the OSU Buckeyes football team won its eighth NCAA football championship, and the first football championship within the new and inaugural collegiate football playoff structure.

7. As a result of OSU's fame and its extensive use, advertising, and sale of goods bearing the OSU Marks, the OSU Marks have acquired strong secondary meaning, achieved favorable national recognition, and become assets of significant value as symbols pointing only to OSU, its services, products, and goodwill.
8. OSU strictly controls the nature and quality of the goods bearing its marks and its trade dress to protect the tradition, prestige, and goodwill associated with these marks, and OSU makes systematic efforts to safeguard the quality and integrity of its marks.
9. For more than thirty (30) years, OSU has licensed third-parties to use its marks—including the OSU Marks—on various items and services, including but not limited to clothing apparel of all types, athletic uniforms, calendars, novelties, books, household goods, toys, sporting goods, home furnishings, glassware, collectibles, pens and watches, food products, restaurant services, internet websites, screen savers, video games<sup>1</sup>, and computer application software for mobile phones and handheld computers.
10. OSU's licensing program has become the most profitable collegiate licensing program in the United States. OSU's licensing revenues are in the millions each year and continue to soar. After OSU's recent National Football Championship win, OSU anticipates revenue in the realm of \$17 million dollars in royalties this year alone. The past and current success of OSU's academic and athletic programs has resulted in extensive exposure of OSU's trademarks—including the OSU Marks—to a national audience and has created a large demand for products and services bearing OSU's trademarks throughout the United States.
11. OSU is the owner of, among others, the following federal trademark registration:

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<sup>1</sup> OSU previously licensed the OSU Marks to producers of video games; however, these video games are still available for sale through on-line retailers.

OSU—Registration No. 1,121,595, registered July 3, 1979, for providing college sport exhibition events and recreation programs, providing dramatical and musical entertainment events and providing college level educational courses;

(the “OSU Registered Mark”).

12. Pursuant to Trademark Rule 2.122(d)(1), OSU hereby provides proof of status and title of the OSU Registered Mark by filing a copy of the records from the USPTO electronic database attached hereto as Exhibit A.
13. The certificate of registration identified in paragraph 11 is valid and subsisting and prima facie evidence of the validity of the registration, of OSU’s ownership of the OSU Registered Mark, of OSU’s exclusive right to use the OSU Registered Mark in commerce in connection with the goods and services specified under the provisions of 15 U.S.C. § 1057(b), and constructive notice of OSU’s claim of ownership under 15 U.S.C. § 1072. Moreover, this registration is incontestable, which provides conclusive evidence of its validity, of OSU’s ownership of the mark and of OSU’s exclusive right to use the OSU Registered Mark in commerce under 15 U.S.C. § 1115(b).
14. In addition, OSU owns common law rights in the OSU marks for use in connection with a number of products, including but not limited to computer application software, all as a direct result of the success of OSU’s athletic programs and subsequent expansion of OSU’s licensing program (the OSU Registered Mark and the common law OSU marks are collectively referred to as the “OSU Marks”).
15. OSU approves and maintains quality control over all of the products and services it licenses and produces under the OSU Marks, and the public assumes OSU has approved, sponsored or endorsed all products and services bearing its trademarks.
16. Applicant has applied for OSU! as a standard character mark for use in connection with:

computer game software, computer game software downloadable from a global computer network, computer game software for use on mobile and cellular phones, in Class 9; and entertainment services, namely, providing online video games in Class 41.

17. OSU has continuously and long prior to September 16, 2007 (the alleged first use date of the Applied-for Mark by Applicant for use in connection with its Class 41 entertainment services) and July 7, 2007 (the alleged first use date of the Applied-for Mark by Applicant for use in connection with its Class 9 computer software goods), used “OSU” as a trademark or made use in a manner analogous to trademark use.
18. Applicant’s OSU! mark is legally identical to Opposer’s OSU Marks such that confusion is likely. Indeed, “OSU” is the dominant portion of the Applied-for Mark, and the addition of an exclamation point to the Applied-for Mark does nothing to obviate confusion. In fact, given the manner in which Opposer’s OSU Marks are used in connection with the promotion of collegiate athletics, the “!” could in effect exacerbate confusion.
19. In the case at hand, overlap of, among, and between the respective goods and services exists. Specifically, Applicant’s proposed goods and services are very broad and such that they could include OSU’s registered services as the subject matter of its computer game software and online video games, including video games that may be about or involve sport exhibition events, dramatical and musical entertainment events, or even for the purposes of education.
20. Applicant’s Applied-for Mark is confusingly similar to Opposer’s OSU Marks such that one would reasonably expect it to emanate from OSU, and the contemporaneous use thereof is likely to cause confusion, mistake, or deception in that the purchasing public is

likely to believe that Applicant or Applicant's goods emanate from, or are in some way associated or connected with, or sponsored, licensed, or authorized by OSU, all to the damage of Opposer and should be refused registration under Section 2(d) of the Lanham Act.

21. The Applied-for Mark is for use on computer software and entertainment services that, upon information and belief, will be advertised and sold to the same consuming public that OSU's products and services are advertised, offered, and sold to under the OSU Marks—namely the students, alumni, fans and supporters of OSU. As a result, given the fame of Opposer's OSU Marks in connection with its educational and athletic programs and the vast array of licensed products sold in connection therewith, Applicant's mark creates a false sense of connection between the mark and Opposer under Section 2(a).
22. The submitted specimen shows the caption: "*OSU! Goodies*" with a sub-caption "*Share OSU! Goodness with shirts, hoodies, mugs and much more*" on a screen shot of the website. Applicant's specimen filed with the United States Patent and Trademark Office is attached as Exhibit B. These listed items conflict with OSU's licensing and merchandising efforts, which include selling shirts, hoodies, mugs, and countless other home goods and apparel in connection with Opposer's OSU Marks. As such, this identical mark also incorporates other similar goods and services thereby suggesting a false connection with The Ohio State University.
23. OSU is a state institution that thrives off of alumni donations. Many of these donations come from graduates all over the country through online portals. Applicant's submitted specimen shows the caption "*Support OSU.*" See Exhibit B. Opposer believes this is highly problematic and conflicts with its ongoing fundraising efforts as it frequently asks



graduates and fans to “support OSU”, further evidence that Applicant’s OSU! mark may falsely suggest a connection with The Ohio State University.

24. Given OSU’s use of the OSU Marks for decades in connection with its educational and athletic programs, and its subsequent expansion of the OSU Marks for use in connection with the vast array of licensed products sold in connection there with, the OSU Marks became famous long before Applicant’s alleged first use dates. As such, the Applied-for Mark dilutes the distinctiveness of Opposer’s OSU Marks under Section 43(c).
25. By reason of the foregoing, Opposer’s opposition should be sustained and Applicant’s application refused registration pursuant to Section 13 of the Trademark Act (15 U.S.C. § 1063).

WHEREFORE, Opposer prays that this Notice of Opposition be sustained and that Application Serial No. 86/450,687 Applied-for Mark be refused registration.

The fee of \$600 as provided by Sections 13 and 31 of the Trademark Act of 1946 is paid by credit card upon electronic filing of this Notice of Opposition. Please recognize Samantha M. Quimby and Kathryn A. Comella, both members of the Bar of the State of Ohio, as its attorneys to prosecute this Notice of Opposition and to transact all business in the Patent and Trademark Office in connection herewith. Please address all communications and correspondence to: Samantha M. Quimby, Frost Brown Todd LLC, 10 West Broad Street, Suite 2300, Columbus, Ohio 43215, Telephone 614.559.7282, Facsimile 614.464.1737, e-mail squimby@fbtlaw.com.

Date: August 19, 2015

Respectfully submitted,



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Samantha M. Quimby

Kathryn A. Comella

Frost Brown Todd LLC

One Columbus

10 West Broad Street

Suite 2300

Columbus, Ohio 43215-3484

Telephone: (614) 559-7282

Facsimile: (614) 464-1737

*Attorney for The Ohio State University*

**CERTIFICATE OF SERVICE**

I hereby certify that a copy of the Notice of Opposition Applicant by First Class International Mail, postage prepaid, on Dean L Herbert, TA ppy Pty Ltd ACN 163 593 413, 41 Gregory Street, Wembley 6014 Australia on this 19th day of August, 2015.



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Samantha M. Quimby  
*Attorney for The Ohio State University*

# EXHIBIT A



## United States Patent and Trademark Office

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## Trademarks &gt; Trademark Electronic Search System (TESS)

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## Record 1 out of 1

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**OSU**

<b>Word Mark</b>	OSU
<b>Goods and Services</b>	IC 041. US 107. G & S: PROVIDING COLLEGE SPORT EXHIBITION EVENTS AND RECREATION PROGRAMS, PROVIDING DRAMATICAL AND MUSICAL ENTERTAINMENT EVENTS AND PROVIDING COLLEGE LEVEL EDUCATIONAL COURSES. FIRST USE: 18780501. FIRST USE IN COMMERCE: 18780501
<b>Mark Drawing Code</b>	(1) TYPED DRAWING
<b>Serial Number</b>	73042961
<b>Filing Date</b>	January 29, 1975
<b>Current Basis</b>	1A
<b>Original Filing Basis</b>	1A
<b>Registration Number</b>	1121595
<b>Registration Date</b>	July 3, 1979
<b>Owner</b>	(REGISTRANT) OHIO STATE UNIVERSITY, THE AN INSTITUTE OHIO 190 N. OVAL DRIVE COLUMBUS OHIO 43210
<b>Attorney of Record</b>	Brian J. Downey
<b>Type of Mark</b>	SERVICE MARK
<b>Register</b>	PRINCIPAL

**Affidavit Text** SECT 15. SECT 8 (6-YR). SECTION 8(10-YR) 20090820.

**Renewal** 2ND RENEWAL 20090820

**Other Data** CONCURRENT USE WITH REG. NO. 1121596 FOR THE AREA COMPRISING THE STATES OF CONNECTICUT, DELAWARE, ILLINOIS, INDIANA, KENTUCKY, MAINE, MARYLAND, MASSACHUSETTS, MICHIGAN, MINNESOTA, NEW HAMPSHIRE, NEW YORK, OHIO, PENNSYLVANIA, RHODE ISLAND, VERMONT, VIRGINIA, WEST VIRGINIA, AND WISCONSIN AND THE PORTION OF THE STATE OF IOWA COMPRISING THE COUNTIES OF BUTTER, FLOYD, GRUNDY, JASPER, LUCAS, MARION, MARSHALL, MITCHELL, AND WAYNE, AND ALL COUNTIES EAST THEREOF.

**Live/Dead Indicator** LIVE

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Generated on: This page was generated by TSDR on 2015-08-19 15:34:08 EDT

Mark: OSU

**OSU**

US Serial Number: 73042961

Application Filing Date: Jan. 29, 19

US Registration Number: 1121595

Registration Date: Jul. 03, 19

Register: Principal

Mark Type: Service Mark

Status: The registration has been renewed.

Status Date: Aug. 20, 2009

**Mark Information**

Mark Literal Elements: OSU

Standard Character Claim: No

Mark Drawing Type: 1 - TYPESET WORD(S) /LETTER(S) /NUMBER(S)

**Concurrent Use:** CONCURRENT USE WITH REG. NO. 1121596 FOR THE AREA COMPRISING THE STATES ILLINOIS, INDIANA, KENTUCKY, MAINE, MARYLAND, MASSACHUSETTS, MICHIGAN, MINNAPOLIS, NEW YORK, OHIO, PENNSYLVANIA, RHODE ISLAND, VERMONT, VIRGINIA, WEST VIRGINIA, AND THE CITY OF THE STATE OF IOWA COMPRISING THE COUNTIES OF BUTTER, FLOYD, GRUNDY, JEFFERSON, MITCHELL, AND WAYNE, AND ALL COUNTIES EAST THEREOF.

**Goods and Services****Note:**

The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;
- Double parenthesis ((.)) identify any goods/services not claimed in a Section 15 affidavit of incontestability; and
- Asterisks \*..\* identify additional (new) wording in the goods/services.

**For:** PROVIDING COLLEGE SPORT EXHIBITION EVENTS AND RECREATION PROGRAMS, PROVIDING ENTERTAINMENT EVENTS AND PROVIDING COLLEGE LEVEL EDUCATIONAL COURSES

International Class(es): 041 - Primary Class

U.S Class(es): 107

Class Status: ACTIVE

Basis: 1(a)

First Use: May 01, 1878

Use in Commerce: May 01, 1878

**Basis Information (Case Level)**

Filed Use: Yes	Currently Use: Yes
Filed ITU: No	Currently ITU: No
Filed 44D: No	Currently 44D: No
Filed 44E: No	Currently 44E: No
Filed 66A: No	Currently 66A: No
Filed No Basis: No	Currently No Basis: No

**Current Owner(s) Information**

Owner Name: OHIO STATE UNIVERSITY, THE

Owner Address: 190 N. OVAL DRIVE  
COLUMBUS, OHIO 43210  
UNITED STATES

Legal Entity Type: AN INSTITUTE

State or Country Where Organized: OHIO

**Attorney/Correspondence Information****Attorney of Record**

Attorney Name: Brian J. Downey

Attorney Primary Email [bdowney@fbtlaw.com](mailto:bdowney@fbtlaw.com) Attorney Email Authorized: Yes

Address:

**Correspondent**

Correspondent Name/Address: Brian J. Downey  
Frost Brown Todd LLC  
Suite 2300  
10 West Broad Street  
Columbus, OHIO 43215-3484  
UNITED STATES

Phone: 614.559.7281 Fax: 614.464.1

Correspondent e-mail: [bdowney@fbtlaw.com](mailto:bdowney@fbtlaw.com) Correspondent e-mail Yes  
Authorized:

**Domestic Representative**

Domestic Representative Name: JOSEPH R DREITLER

**Prosecution History**

Date	Description	Proceeding Number
Nov. 15, 2010	NOTICE OF SUIT	
Aug. 30, 2010	NOTICE OF SUIT	



Aug. 20, 2009	REGISTERED AND RENEWED (SECOND RENEWAL - 10 YRS)	74886
Aug. 20, 2009	REGISTERED - SEC. 8 (10-YR) ACCEPTED/SEC. 9 GRANTED	
Jul. 23, 2009	ASSIGNED TO PARALEGAL	74886
Jul. 20, 2009	TEAS SECTION 8 & 9 RECEIVED	
Jan. 15, 2008	CASE FILE IN TIGRS	
Oct. 15, 2007	ATTORNEY REVOKED AND/OR APPOINTED	
Oct. 15, 2007	TEAS REVOKE/APPOINT ATTORNEY RECEIVED	
Aug. 07, 2007	ATTORNEY REVOKED AND/OR APPOINTED	
Aug. 07, 2007	TEAS REVOKE/APPOINT ATTORNEY RECEIVED	
Aug. 05, 1999	REGISTERED AND RENEWED (FIRST RENEWAL - 10 YRS)	
Jun. 30, 1999	REGISTERED - SEC. 9 FILED/CHECK RECORD FOR SEC. 8	
Jan. 09, 1985	REGISTERED - SEC. 8 (6-YR) FILED	
Jan. 14, 1985	REGISTERED - SEC. 8 (6-YR) ACCEPTED & SEC. 15 ACK.	
Aug. 22, 1984	REGISTERED - SEC. 8 (6-YR) & SEC. 15 FILED	

**Maintenance Filings or Post Registration Information**

Affidavit of Continued Use: Section 8 - Accepted

Affidavit of Incontestability: Section 15 - Accepted

Renewal Date: Jul. 03, 2009

**TM Staff and Location Information**

TM Staff Information - None

**File Location**

Current Location: POST REGISTRATION

Date in Location: Aug. 20, 2009

**Assignment Abstract Of Title Information - Click to Load****Proceedings - Click to Load**

# EXHIBIT B



osu!

Dean

https://osu.ppy.sh

osu!



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RHYTHM IS JUST A CLICK AWAY

5,192,787 users, 11,381 online now.  
A total of 2.72 billion ranked plays!

Info

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Beatmaps

Rankings

Community

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User

Beatmap

Welcome, **peppy** **ppy** 1 message Search Settings Logout

News

**14.10.17 September 2014 Monthly Ranking Charts**

The Ranking Charts for September 2014 have just been released and can be found here! Along with that, we updated the Ranking Charts long-term leaderboard with the new results! Moreover, we published the vote results here!

**14.10.10 Third Official osu! Fanart Contest Results!**

Hey there. We received so many awesome entries for the third official osu! fan art contest "Stickers! So Many Stickers!" - with the theme of digital stickers (like the ones used on Facebook or Line or other chat programs as large emoticons). Again, the creativity of fans knocked us off our feet; We can definitely see some of these submissions being the perfect way to express osu!-related emotions in chat programs. Well done guys.

**14.10.02 osu! World Cup 2014 - Registration Phase**

We'd like to welcome all of you to this year's official osu! World Cup. The rules have been adjusted from the previous OWC, so please read them carefully before registering for this tournament.

**14.10.01 Official osu! Fanart Contest 4 Begins!**

Hi there! New osu! staffer here. I'll soon be taking over the running of the osu! webstore (yes, that means restocked osu! tablets soon!) but today I'm here to introduce the fourth Official osu! Fanart Contest! This time, things are getting spooky with the theme of...

**DOWNLOAD OSU!**

Start your own rhythmical adventure today!

**OSU! GOODIES**

Share osu! goodness with shirts, hoodies, mugs and much more!

**SUPPORT OSU!**

Become a subscriber and get many enhancements including in-game downloading.

PLAYLIST 1 / 179 Let's play Osu! - Part ...



videos managed by VideosuTV!

**Online Users** over the last 24 hours



Peak: 12479 users

**Game Chat** also connect from irc://cha.ppy.sh

01:14:31 NoobJumper : asa/n[  
01:14:34 \* NoobJumper is playing [http://osu.ppy.sh/b/244117 Yuyoyuppe - Reon [Insane]]  
01:14:38 bjvbrody : hehe <3

**Most Played Beatmaps** over the last 24 hours

Plays	Artist / Title	Creator
33,000	Kuba Oms - My Love	White
21,331	cYsmix feat. Emmy - Tear Rain	jonathanlfj
17,762	Rameses B - Flaklypa	-kevincela-